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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,236	06/24/2003	Bruce H. Storm	1391-34500	8527
23505	7590	03/13/2006	EXAMINER	
CONLEY ROSE, P.C. P. O. BOX 3267 HOUSTON, TX 77253-3267			VERBITSKY, GAIL KAPLAN	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/602,236	Applicant(s) STORM ET AL.	
	Examiner Gail Verbitsky	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-15, 17-25, 27, 28, 45-48, 50-65, 67-76 and 78-84 is/are pending in the application.
- 4a) Of the above claim(s) 29-44 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45-48, 50-65, 67 and 68 is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10-15, 17-25, 27, 28, 69-72, 74-76, 78-80 and 82-84 is/are rejected.
- 7) ☒ Claim(s) 2, 73 and 81 is/are objected to.
- 8) ☒ Claim(s) 29-44 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-4449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/21/2005</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claims 1, 69 are finally objected to because of the following informalities: the newly added limitation stating "is capable of managing the temperature" makes the claim language confusing. Perhaps applicant should: A) add --by keeping it within predetermined limits—after "thermal component" in line 10, and, B) add -- by removing and -- before "storing heat" in line 10. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-8, 10-12, 15, 25, 27-28, 69-72, 74-76, 78-80, 82-84 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Flores (U.S. 5701751).

Flores discloses in Figs. 1-11 a device in the field of applicant's endeavor. Flores emphasizes the need of actively cooling a downhole logging tool electronics (col. 4, lines 61-62). Flores discloses a thermal component (heat generating component) 37 in a hot borehole environment, in thermal communication with a hot heat exchanger 24, 39 a thermal conduit system (heat pipes) 43 thermally coupling the heat exchanger 39 with a low tank (heat storage/ heat sink) 50 of water (eutectic heat phase change liquid) and all within a Dewar flask/ thermal barrier/ (col. 5, line 47). The heat storage 50 is capable to manage the temperature of the component by removing an excessive heat from the

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component when necessary and storing the heat and dissipating the heat. The heat sink/ heat storage 50 absorbs heat from the overheated thermal component. The heat storage stores the heat for some time till a cooling liquid in the heat storage boils, and, thus, the heat storage reaches its capacity. Then, the heat from the heat storage is removed by a compressor pumping (pump) the heat/ steam from the cooling agent in the heat storage, and condensing the steam into the cooling agent. The device, inherently, has a valve, for controlling the cooling fluid flow. It is also inherent, that, as shown above, the system is working as a closed loop system. The thermal component is a heat-generating component that overheats during operating or, inherently, when the environment (borehole) overheats.

The heat exchanger, the heat storage and the thermal conduit are located in the downhole tool.

The method steps will be met during the normal operation of the device stated above.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-14 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Flores in view of Boesen (U.s. 4375157).

Flores discloses the device/ method as stated above.

Although Flores teaches a Dewar flask thermal insulation, Flores does not explicitly teach all the limitations of claims 13-14.

Boesen discloses a device in the field of applicant's endeavor including a vacuum insulated (evacuated) Dewar flask container.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Flores, so as to have a vacuum insulated/ evacuated thermally insulated container, as taught by Boesen, so as to better control the temperature of the cooling fluid, and thus, to achieve sufficient thermal component cooling.

6. Claims 17-18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Flores.

Flores discloses the device/ method as stated above.

Flores does not explicitly teach a plurality of heat exchangers and the particular sized pump.

With respect to claim 17: having a plurality of heat exchangers, absent any criticality, is only considered to be an obvious modification of the system disclosed by Flores. While the addition of multiple heat exchangers to the concept of Flores undoubtedly makes the invention more useful with a plurality of heat exchangers, it is not the type of innovation for which a patent monopoly is to be granted. See In re St. Regis Paper Co. v. Bemis Co., Inc., 193 USPQ 8, 11 (7<sup>th</sup> Cir. 1977).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Flores, so as to have a

plurality of heat exchangers, so as to provide the operator with fast and efficient cooling system.

7. Claims 17-24 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Flores in view of Drube et al. (U.S. 6799429) [hereinafter Drube].

Flores discloses the device/ method as stated above.

Flores does not explicitly teach a plurality of heat exchangers parallel or in series, as stated in claims 17-24.

Drube discloses a cooling device comprising a section of parallel-connected heat exchangers and a section of serially connected heat exchangers that provide a maximum fluid flow capability.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Flores, so as to have a plurality of parallel and serially connected heat exchangers, as taught by Drube, so as to provide a maximum fluid flow capability, as already suggested by Drube.

#### ***Allowable Subject Matter***

8. Claims 2, 73, 81 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 45-48, 50-65, 67-68 are allowed.

#### ***Response to Arguments***

9. Applicant's arguments filed on December 20, 2005 have been fully considered but they are not persuasive.

Applicant states that Flores is different in that Flores manages temperature by transferring the heat to another location rather than storing in the tank 50, while the instant invention requires a heat storage unit capable of managing temperature of the thermal component by storing heat from the thermal component rather than transferring the heat into another location.

This argument is not persuasive because, A) as shown in paragraph 3 of the Office action, in Flores, "the heat storage is capable to manage the temperature of the component by removing an excessive heat from the component when necessary and storing the heat and dissipating the heat. The heat sink/ heat storage 50 absorbs heat from the overheated thermal component. The heat storage stores the heat for some time till a cooling liquid in the heat storage boils, and, thus, the heat storage reaches its capacity. Then, the heat from the heat storage is removed by a compressor pumping (pump) the heat/ steam from the cooling agent in the heat storage, and condensing the steam into the cooling agent", B) the Applicant, in the specification, paragraphs [0044] and [0053], states that when the heat sink/ storage reaches it's capacity, the heat stored in the heat storage is removed to a cooler environment. Therefore, both, Flores and Applicant, disclose storing the heat and then removing the heat.

Applicant states that the Examiner does not have a motivation to combine references. In response to applicant's argument, the examiner recognizes that there should be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). The references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

With respect to the "inherency" statement: applicant states that the fact that a result or characteristic may occur in the prior art is not sufficient to establish inherency". This argument is not persuasive because, in Flores, the valve is not a choice but is necessary to regulate the flow of vapor and water. Also, Flores states that there is a compressor. In addition, Flores states (col. 3, lines 52-54) that a compressor is a heat exchanger.

It has been held that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute limitations in any patentable sense. In re Hutchinson, 69 USPQ 138.

### ***Conclusion***

**10. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gail Verbitsky whose telephone number is 571/ 272-2253. The examiner can normally be reached on 7:30 to 4:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on 571/ 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GKV

Gail Verbitsky  
Primary Patent Examiner, TC 2800



February 21, 2006